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OFFICE OF PETITIONS

In re Patent No. 7,516,118 :  
Badros et al. :  
Issue Date: April 7, 2009 :  
Application No. 10/749,440 : DECISION ON REQUEST FOR  
Filed: December 31, 2003 : RECONSIDERATION OF  
Attorney Dkt. No. 16113- : PATENT TERM ADJUSTMENT  
1101001/GP-167-00 :  
Title: Method and System For :  
Assisted Network Browsing :

This is in response to the "Application For Patent Term Adjustment Under 37 C.F.R. §1.705(d)" filed Monday, June 8, 2009. Patentees request that the patent term be adjusted from 588 days to 841 days.

The request for reconsideration of patent term adjustment is **DISMISSED**.

On April 7, 2009, the above-identified application matured into US Patent No. 7,516,118 with a patent term adjustment of 588 days. This request for reconsideration of patent term adjustment (including the required fee) was timely filed within two months of the issue date of the patent. See 37 CFR 1.705(d).

Patentees request recalculation of the patent term adjustment based on the decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees assert entitlement to a patent term adjustment of 841 days (232 + 661 reduced by 52 (applicant delay)). Patentees also contend that a reduction of 17 days is required and that the 40-day reduction was made in error.

Consideration first turns to patentees' contentions that periods of reduction for applicant delay are in error. Pursuant to their duty of candor and good faith, patentees disclose that entry of 17-day reduction pursuant to 37 CFR 1.704(c)(8) is required for the submission of a supplemental reply in the form of a Request for Continued Examination (RCE) on August 20, 2007, subsequent to the amendment filed on August 3, 2007. Patentees are incorrect. A review of the record shows that the 17-day reduction is not warranted. As the amendment filed August 3, 2007 was not in compliance with the § 1.113(c), the period for reply to the final rejection mailed on June 6, 2007, continued to run. The proper reply, the RCE was received in the Office on August 20, 2007. As the RCE was filed within the three-month period provided for in § 1.704(b), no period of reduction was entered for applicant delay.

Patentees argue the supplemental response filed on November 17, 2008 warrants a reduction of 2-days pursuant to 37 CFR 1.704(c)(8) not the current reduction of 40-days.

Patentees are advised that any request for reconsideration under 37 CFR 1.705(d) that raises issues that were raised, or could have been raised, in an application for patent term adjustment under 37 CFR 1.705(b) shall be dismissed as untimely as to those issues. As the 40 day reduction contested by patentees could have been raised under 37 CFR 1.705(b), patentees' request for reconsideration of said 40 day reduction is dismissed as untimely.

As such, the total reduction for applicants' delay remains 73 days.

Consideration now turns to patentees' assertion that the Office's calculation of "B delay" for issuance beyond three years from filing is incorrect. Considering the overlap provision, the Office entered 0 days for this period. Patentees maintain that considering the overlap provision, 232 days should have been entered. The Office finds that as of the filing of the request for continued examination (RCE) on August 20, 2007, the application was pending three years and 232 days after its filing date. An entry of a period of adjustment of 661 days was entered for Office delay. At issue is whether patentees should accrue 232 days of patent term adjustment for the Office taking in excess of three years to issue the patent as well as 661 days

for Office failure to take a certain action within a specified time frame (or examination delay).

The Office contends that 232 days overlap. 35 U.S.C.

154(b)(2)(A) limits the adjustment of patent term, as follows:

To the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C.*

154(b)(2)(A), 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR

§ 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

As such, the period for over 3 year pendency does not overlap only to the extent that the actual dates in the period beginning three years after the date on which the application was filed overlap with the actual dates in the periods for failure of the Office to take action within specified time frames.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the filing date December 31, 2003 until the filing of the RCE on August 20, 2007. (There were no periods excluded under 35 U.S.C. 154(b)(1)(B)(ii)-(iii)). Prior to the filing of the RCE, 661 days of patent term adjustment were accorded for the Office failing to respond within a specified time frame during the pendency of the application. (No periods of adjustment for Office delay accrued subsequent to the filing of the RCE).

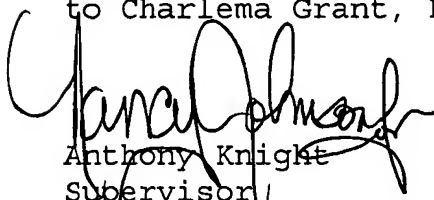
The Office did not delay 661 days and then delay an additional 232 days. Accordingly, 661 days of patent term adjustment for Office delay (not 661 days and 232 days) was properly entered because the entire period of delay of 232 days attributable to the delay under 37 CFR 1.702(b) overlaps with the 661 days attributable to grounds specified in § 1.702(a)(1).

Accordingly, at issuance, the Office properly entered no additional days of patent term adjustment pursuant to 37 CFR 1.702(b).

In view thereof, the Office affirms that the revised determination of patent term adjustment at the time of the issuance of the patent is 588 days (661-73).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to Charlema Grant, Petitions Attorney, at (571) 272-3215.



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